

Advisory Action

Application No.

10/051,889

Applicant(s)

SCHWARTZ ET AL.

Examiner

Frances P. Oropeza

Art Unit

3762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

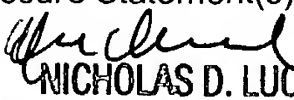
The status of the claim(s) is (or will be) as follows:

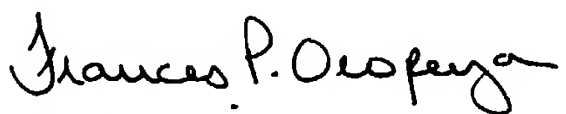
Claim(s) allowed: _____.

Claim(s) objected to: 3, 13 and 15.Claim(s) rejected: 1, 2, 4-12, 14 and 16.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


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Continuation of 3.

Applicant's reply has overcome the following rejection(s): 35 U.S.C.102(e) as being anticipated by Er et al. (US 5971341).

The Applicant's arguments related to the 35 U.S.C.102(e) rejection as being anticipated by Alt et al. (US 6073049), filed 6/3/04, have been fully considered, but they are not convincing.

The Applicant asserts since the Alt et al. pacemaker is adapted to be selectively upgraded after implantation to provide different diagnostic, functional, and pacing operation modes, and since charges/upgrade codes are required to make changes to a pacemaker with limited functionality, the Alt et al. reference does not disclose or suggest a controller responsive to the receipt of a reset signal to retrieve parameter data from the parameter storage unit corresponding to another of the programming states and to implement the parameter data to change the programming state. The Examiner disagrees. The diagnostic, functional, and pacing operational modes are read to be individual treatment options that can be initiated at the physician's discretion (col. 5 @ 7-17). In this rejection, the operational modes are read as the "programming states" (col. 4 @ 16-20). While the pacemaker at the point of implantation can have limited pacing capability (col. 7 @ 2-35), it can also, at the point of implantation be given full capability so reprogramming by the physician can be undertaken without the need to have charges/ upgrade codes (col. 9 @ 29-45).

While, as asserted by the Applicant, the operational modes selected may require further parameter adjustments, the Examiner reads the different operating modes, such as an anti-bradycardia mode, an anti-tachycardia mode, and a rate adaptive pacing mode, as each having defined parameters that constitute a unique programming state, each state with defined parameters not requiring adjustment to be functional (col. 4 @ 16-30; col. 9 @ 29-45), hence Alt et al. teach in a fully capable pacemaker the limitation of a controller responsive to the receipt of a reset signal to retrieve parameter data from the parameter storage unit corresponding to another of the programming states and to implement the parameter data to change the programming state.

In response to the Applicant's argument that the reference fails to show certain features of the Applicant's invention, it is noted that the features upon which the Applicant relies (i.e. the resetting of the programming state constituting "all operating parameters" and including the parameters associated with the diagnostic, functional and pacing operation modes) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *in re Van Geuns*, 988 F.2d 1181, 26 USP2d 1057 (Fed. Cir. 1993).

The rejection of record stands for the reasons of record and the discussion above.

JPO
7/8/04